

REMARKS

This submission is responsive to the Office Action with a mailing date of June 26, 2006. Claims 1-30 are pending in the present application. Of these, claims 1-16 and 22-26 have been examined and stand rejected. Claims 17-21 and 27-30 were withdrawn from consideration in the Office Action based on a previously imposed restriction requirement, and have correspondingly been cancelled herein without prejudice to consideration in a later filing. Claims 8, 12, and 22 have been amended to specifically recite a fluoropolymer. Claims 1, 8, 12 and 22 have been amended to refer to the inclusion of oxygen-containing organic groups in the treated fluoropolymer material. Support for these amendments is found for example at page 8, lines 2-26. Dependent claims 9, 13 and 25, which recited a fluoropolymer, have been cancelled due to the amendments to their corresponding independent claims. Claim 10 has been amended to change its dependency from claim 9, now cancelled, to claim 8. The amendments made above introduce no new subject matter. Reconsideration of the present application as amended is respectfully requested.

Currently, claims 1-8, 10-12, 14-16, 22-24 and 26 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,139,510 to Palermo ("the Palermo reference"). The Applicants respectfully traverse.

A prior art reference does not anticipate a patent claim unless the reference discloses, either expressly or inherently, all of the limitations of the claim. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 771, 218 USPQ 781, 789 (Fed. Cir. 1983). Moreover, a limitation cannot be found to be inherent in a reference unless that limitation necessarily occurs in the reference. As the court stated in *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981): "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." Still further, the Court of Appeals for the Federal Circuit has held that anticipation will not occur unless "the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). This is the legal standard for

determining whether the claims under consideration are anticipated by a prior art reference.

It is respectfully submitted that the Palermo reference does not anticipate claims 1-8, 10-12, 14-16, 22-24 and 26 for the reasons that follow, and withdrawal of the rejection of these claims on this basis is respectfully requested.

The Examiner states “Palermo teaches a medical guidewire comprising an elongate wire, an etched hydrocarbonaceous surface, wherein the hydrocarbon can be a fluoropolymer and a lubricious coating adhered thereto.” The Palermo reference discloses the use of a layer in between the guidewire core and a lubricious, biocompatible, hydrophilic polymer coating – this layer is termed a “tie layer.” One way to apply a tie layer “is via the use of a plasma stream to deposit a hydrocarbon or fluorocarbon residue.” (col. 12, lines 63-64) It appears from the comments in the Office Action that the Examiner asserts that a fluoropolymer applied as a tie layer in this manner will result in an “etched hydrocarbonaceous surface.” Respectfully, the Palermo reference does not teach that this is the case.

The Examiner’s position relies on the classifying of fluorocarbons as a “hydrocarbon” and the presumption that the Palermo reference teaches that all of these “hydrocarbons” produce a hydrocarbonaceous residue. This is not the case. The Palermo reference starts with a broad disclosure that a *hydrocarbon or fluorocarbon residue* is produced as a result of preparing the tie layer in this way (col. 12, lines 63-64). The specification follows immediately thereafter with the detailed procedure for producing that hydrocarbon or fluorocarbon residue (col. 12, line 65). Thereafter, the term “hydrocarbon” is used to refer to an alkane, alkene or fluorocarbon (col. 13, lines 3-7); presumably “hydrocarbon residue” (col. 13, lines 21 and 24) is consistent with this use and, therefore, refers to an alkane, alkene or fluorocarbon residue.

Furthermore, the deposition of a hydrocarbonaceous residue is specifically described only in the Examples. Examples 1 and 2 use methane, (col. 14, lines 11 and 28), an alkane which “deposits a hydrocarbonaceous residue...” (col. 14, lines 14-15) Example 3 uses ethane, (col. 14, line 46), also an alkane, and states that it deposits a hydrocarbonaceous residue. Clearly, the Palermo reference only discloses deposition specifically of a hydrocarbonaceous residue as a result of use of a plasma stream of an

alkane, not a fluorocarbon. The Palermo reference, when viewed in light of what it would teach an ordinary person having skill in the art, does not teach that a fluorocarbon polymer can be applied in the manner described, resulting in a “hydrocarbonaceous surface”.

Additionally, Palermo does not disclose a “carbonaceous surface including oxygen-containing organic groups formed at positions at which fluorine atoms of said fluoropolymer coating have been removed” as set forth in the combination of claim 1. For at least these reasons, claim 1 is not anticipated by the Palermo reference.

Claims 2-7 depend from claim 1. For at least the above stated reasons, they should be allowed.

Claim 8, as amended, recites “A medical device, comprising: an elongate member for traversing a bodily passage; the elongate member including a fluoropolymer portion having an etched carbonaceous surface, said etched carbonaceous surface including oxygen-containing organic groups formed at positions at which fluorine atoms of said fluoropolymer portion have been removed; and a lubricous and/or therapeutic coating on said surface. For at least the reasons discussed above with respect to claim 1, the Palermo reference does not teach an etched fluoropolymer portion having a carbonaceous surface with the claimed features. Accordingly, claim 8 and claims 10-11 dependent thereon are believed to be allowable over Palermo, and withdrawal of this rejection is solicited.

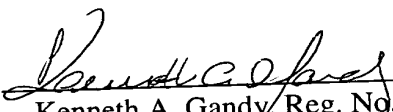
Claim 12, as amended, recites “A medical device, comprising: a member for traversing or implantation within a bodily passage; the member having an etched fluoropolymer portion having a carbonaceous surface, said carbonaceous surface including oxygen-containing organic groups formed at positions at which fluorine atoms of said fluoropolymer portion have been removed; and a lubricious and/or therapeutic coating adhered to said carbonaceous surface.” For at least the reasons discussed above the Palermo reference does not teach an etched fluoropolymer portion having a carbonaceous surface with the claimed features, and claim 12 should be allowed. Claims 14-16 depend from claim 12 and should be allowed for at least this reason.

Claim 22, as amended, recites: “A medical wire guide, comprising: an elongate member having a fluoropolymer surface; said fluoropolymer surface having been treated

to remove fluorine remove atoms and form oxygen-containing organic groups to increase the hydrophilic character of the fluoropolymer surface; and a lubricious and/or therapeutic coating adhered to the treated polymer surface." For at least the reasons cited above with respect to claim 1, claim 22 is also distinct from the Palmero reference and should also be allowed. Claims 23-24 depend from claim 22 and for at least the above discussed reasons they also should be allowed.

In view of the foregoing, it is believed that claims 1-8, 10-12, 14-16, 22-24 and 26 are in condition for allowance. Reconsideration of the present application as amended is respectfully requested. The Examiner is invited to contact the undersigned attorney by telephone if there are any questions about this response or other matters that may be addressed to advance the prosecution of the application.

Respectfully submitted,

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